

Applicant : Jonathan S. Duke-Cohan et al.
Serial No. : 09/787,097
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Attorney's Docket No. 00530-089002

REMARKS

Telephone interview

Applicants thank Examiner Yvonne Eyler for her helpfulness in a telephone interview with Applicants' undersigned representative on November 2, 2004.

Status of the claims

Claims 2-3, 6, 20-27, 38-40, 46-47, 49-51, and 57-83 are pending and under consideration in this application.

In a telephone conference call with the Examiner and Examiner Eyler on October 28, 2004, Examiner Eyler asserted that, while claims specifying nucleic acids encoding attractin, or fragments of attractin, in terms of specific nucleotide sequences are not obvious over U.S. Patent No. 6,265,551 (the '551 patent) and U.S. Patent No. 6,325,989 (the '989 patent), claims specifying such nucleic acids in terms of the amino acid sequence they encode are obvious in view of these two patents. In an amendment submitted on Friday, October 28, 2004, Applicants amended claims 6, 47, and 49 and added claim 79 to specify attractin (or attractin fragment)-encoding nucleic acids in terms of particular nucleotide sequences. For the reasons given below, Applicants respectfully submit that the '551 and '989 patent are not available as obviousness references against the present application.

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Statement of Co-ownership

Applicants respectfully submit that the invention of the present application and the patent applications that issued as the '551 patent and the '989 patent were owned by, or subject to an obligation of assignment, to the Dana-Farber Cancer Institute, Inc. at the time the invention of the present application was made. Thus, under 35 U.S.C. § 103(c), neither the '551 patent nor the '989 patent is available as an obviousness reference against the present application.

Applicants' undersigned representative attempted to contact Examiner Eyler by telephone on Monday, November 1, 2004, in order to discuss this matter but was unable to reach her. In a telephone conversation with Applicants' undersigned representative the following day (Tuesday, November 2, 2004), Examiner Eyler agreed with the above characterization of the "prior art" status of the '551 patent and the '989 patent in regard to the present application. Upon checking the appropriate records, she noted that the present application had already been allowed and thus it was too late to submit an additional pre-allowance amendment reflecting the unavailability of the '551 patent and the '989 patent as obviousness references. She suggested that Applicants file a 37 C.F.R. § 1.312 amendment appropriately amending relevant claims.

Thus, claims 6, 47, and 65-79 are amended herein under 37 C.F.R. § 1.312 so as specify relevant nucleic acids in terms of attractin amino acid sequences encoded by the specified nucleic acids. These amendments are supported by the specification, e.g., at the paragraph spanning pages 3 and 4; page 9, lines 17-21; and Examples 8 and 9. The amendments made herein add no new matter.

Applicants do not concede that, if the application that issued as the '551 patent (or the application that issued as the '989 patent) and the present application were not commonly owned at the time the invention of the present application was made, claims specifying attractin (or attractin fragment)-encoding nucleic acids in terms of amino acid sequences that the nucleic acids encode would be obvious over the '551 patent (or the '989 patent).

Applicants respectfully request that the amendments made herein be entered and that all the claims be allowed in view of these amendments.

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Respectfully submitted,

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1/31/05



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